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APPLICATION NO.	FILING DATE	FIRST NAME INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BELL, KENT L

ART UNIT 3700

DATE MAILED 12 17 2002

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Please find below and or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,353

Applicant's

CHALLET

Examiner

KENT L BELL

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a), and in no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on response filed 9/25/02
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/16/01 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413; Paper Only)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449; Paper Only) 6 6) ☐ Other

Detailed Action

Status of Application

Applicant's substitute specification, including the amendments, and comments filed September 25, 2002 have been entered and fully considered but are not found persuasive as to the issues set forth in this Office action.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Detailed Action

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. As stated in the previous Office action mailed March 25, 2002, Applicant states the Androecium is present on ray florets. This is not understood and appears botanically incorrect as the androecium is typically found only on disc florets and the gynoecium is typically found on both ray and disc florets. This plant does not have disc florets as set forth on page 8, line 3. Correction and/or clarification is necessary.

Detailed Action

B. As stated in the previous Office action mailed March 25, 2002, Applicant states the instant plant produces pollen. This is not understood and appears botanically incorrect as the instant plant does not have disc florets (as stated on page 8, line 3) and without disc florets, in which the androecium would be located, cannot produce pollen. Correction and/or clarification is necessary.

C. As stated in the previous Office action mailed March 25, 2002, If the leaves are petiolate, applicant should set forth in the specification the typical and observed petiole coloration with reference to the employed color chart.

D. Page 9, line 19. Applicant states leaf shape "Possess dentate lobes.". Even though the leaf may possess dentate lobes, the recitation "possess dentate lobes" does not set forth a leaf shape. Applicant should set forth in the specification the typical and observed leaf shape.

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Detailed Action

Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Claim Rejection - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The Claim is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right application number 15135 (France) or the 1997 Catalog of Challet Herault Productions of Nuaille France in view of applicant's admission that 'Chanoud' was "placed in the hands of the public in France during 1997" (Page 4 of response filed September 25, 2002).

The French application number 15135 was published November 10, 1996. The Catalog of Challet Herault Productions was available to the French in 1997 as stated by application on page

Detailed Action

4 of the response filed September 25, 2002. This printed catalog was in the public domain more than one year prior to the filing of the instant application. The published French application and catalog are a "printed publication" under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. Copies of The French application (15135) are obtainable through the Bulletin Officiel de la Protection des Obtentions Vegetales, which is available to the public.

Thus information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art. A publication relied upon as prior art under 35 USC 102(b) must be enabling. The text of the relied upon publication standing alone would not enable one skilled in the art to practice the claimed invention. However, when the claimed subject matter is disclosed identically by a reference, an additional reference may be relied on to show the primary reference has an "enabled disclosure". *In re Samour*, 571 F.2d 559, 197 USPQ 1 (CCPA 1978) and *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985). See also MPEP § 2131.01. When the claim is drawn to a plant, the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d

Detailed Action

1618, 1620. (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications."). See also MPEP § 2121.03.

Applicant admits on page 4 of the response filed September 25, 2002 that the cultivar 'Chanoud' was placed in the hands of the public in France during 1997. This constitutes evidence that the claimed cultivar was available to the public more than one year before the present application's United States filing date. The Plant Breeder's Right application filing number 15135 is enabled because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation. See, e.g., *Thomson, supra*. See also Cooper, Biotechnology and the Law § 8.05 (1998 Clark Boardman Callaghan). "In essence then, a plant patent applicant cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public."

Response to Arguments

Applicant's arguments have been fully considered as they apply to the new grounds of rejection.

Detailed Action

Applicant argues that the request for information under 37 CFR 1.105 for the Chrysanthemum cultivar 'Chanoud' is irrelevant and is "not reasonably necessary to properly examine or treat the matter.". This argument is not persuasive because examiners are requesting additional information relative to the claimed invention to improve the quality of searches and examination. The rules specifically state requesting information regarding in part:

- any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors or assignee, that relates to the claimed variety;
- any use of the claimed invention which use was known to any of the inventor(s) or assignee(s) at the time the application was filed notwithstanding the date of the use.

Applicant argues that public use and availability in a foreign country more than one year before filing of a patent application in this country is not prior art and the Patent Office has never considered this obstruction to Patent protection. This argument is not persuasive because the rejection is based on the printed publication; the French published the Plant Breeder's Right application number 15135 on November 10, 1996 more than a year of the filing of this plant application. Further The Catalog of Challet Herault Productions was available to the French in 1997 more than a year of the filing of this plant application.

Applicant argues that the information of 'Chanoud' in Exhibits A, B, and C, would not enable a person skilled in the art (plant science) to reproduce the claimed variety. This argument

Detailed Action

is not persuasive because a more detailed description of the claimed cultivar would not confer novelty. See MPEP 2112.

Applicant argues that the plant in *In re LeGrice* was available only in a foreign country, and that the fact situation is the same in the instant application. This argument is not persuasive because in *LeGrice*, Applicant never admitted that the rose cultivar was on sale anywhere. Instead, Applicant stated, "Prior public use or sale are the avenues by which a plant enters the public domain" (*LeGrice*, page 372.). The court then added "section 102(b) requires that an inventor, who has placed his invention in the public domain, file his application within one year thereafter" (*LeGrice*, page 372). The *LeGrice* decision states, "The particular question of law to be here decided is presented on stipulated facts which, insofar as they relate to the issue, are here quoted from the record...". The list of facts that follows does not include the stipulation that the plants sought to be patented were on sale anywhere.

Applicant argues that Foreign Commercial or Public use is not a bar to patentability under 35 U.S.C. 102. This is not relevant. The clear wording of 35 USC 102 (b) is "A person shall be entitled to a patent unless- ...(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States..." There is no restriction of the bar under 35 USC 102(b) to printed publications in this country. The second clause of 35 USC 102(b) barring public sale or use in this country is not relevant because the rejection under 35 USC

Detailed Action

102(b) over the foreign breeder right certificate or French catalog, as enabled by a sale to the public in a foreign country over one year prior to the date of domestic filing, would not be over public use or sale, but over a printed publication. Note that in *Gandy v. Main Belting*, there was no printed publication. Whether the combination of a non-enabling printed publication with foreign commercial use is a bar to patentability under 35 USC 102(b) for utility or plant patents is likewise not at issue. The issue is whether a printed publication, by virtue of enablement by the knowledge of one of ordinary skill in the art where such a person could have obtained the necessary plant stock publicly, was a bar.

Applicant then argues that the *Gandy v. Main Belting Co.* decision was the first to decide that the printed publication and the foreign sale were not grounds of rejection under 102(b). In *Gandy*, there was no printed publication. In *Pentech International Inc. v. Hayduchok*, 18 USPQ2d 1337, it stated that the "on-sale bar" must be "in public use or on sale in this country, more than one year prior to the date on the application for patent in the United States.". *Pentech v. Hayduchok* later states "a foreign use or sale, **without a printed publication** or patent as described in 102(a), will not undermine the validity of a patent issued in the United States" (page 1343). For this instant application, the plant was described in the Plant Breeder's Right application and French catalog which, when combined with commercial availability in a foreign country, would have enabled one skilled in the art to reproduce the claimed invention.

Detailed Action

Applicant argues that the examiner should not rely on *Ex parte Thomson*, because that case involved an application for a utility patent. This argument is not persuasive because the question in *Thomson*, as in *LeGrice*, was, what is required to "enable" a printed publication describing a plant? Except for the type of patent sought, the instant application presents the same fact pattern as the *Thomson* case. Moreover, applicant has misconstrued the *Thomson* decision. The printed publications cited in *Thomson* were not enabled by applicant's deposit of seeds, but by commercial availability of the seeds *outside the U.S.* As stated in *Thomson*, "we are convinced that the skilled cotton grower would have had the wherewithal, upon reading the publicly disseminated reference articles, to purchase the commercial available Siokra seeds, and employ conventional techniques to plant and nurture the seeds to maturity in order to obtain the claimed invention, i.e. Siokra plants, seeds and pollen. It is reasonable to conclude that, at the time the cited articles were published, skilled artisans throughout the world would have found Siokra seeds readily available on the open market."

Applicant further argues that to anticipate a claim then only one reference must be used in the rejection and not in combination. This argument is not persuasive because the rejection (stated above) is based upon one printed publication, the French application 15135 or the 1997 French catalog. There is no combination of references.

Serial Number: 09 759,353
Art Unit: 1661

Page 12

Detailed Action

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (703) 306-3224. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

KENT BELL
PRIMARY EXAMINER

Kent L. Bell